

### **REMARKS**

In the August 15, 2007 Office Action, claims 1-3, 6, 8, 9 and 13 were rejected in view of prior art and claims 4, 5, 7, 10-12 and 14 are withdrawn from consideration. No other objections or rejections were made in the Office Action.

#### ***Status of Claims and Amendments***

In response to the August 15, 2007 Office Action, Applicant has amended claims 1 and 13, as indicated above. Thus, claims 1-14 are pending, claims 4, 5, 7, 10-12 and 14 are withdrawn from consideration, with claims 1, 13 and 14 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of above amendments and the following comments.

#### ***Election of Species***

In paragraph 1 of the Office Action, Applicants' election without traverse filed on June 4, 2007 was acknowledged. Thus, non-elected claims 4, 5, 7, 10-12 and 14 were withdrawn from further consideration. However, Applicants respectfully request that non-elected claims 4, 5, 7, 10-12 and 14 be rejoined in this application upon allowance of a generic or linking claim, or claims.

#### ***Rejections - 35 U.S.C. § 103***

In paragraph 2 of the Office Action, claims 1-3, 6, 8, 9 and 13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,957,002 (Ueng) in view of U.S.

Patent No. 4,184,380 (Rivin). In response, Applicants have amended independent claims 1 and 13 as mentioned above.

More specifically, independent claim 1 now clearly recite that the bicycle component includes a positioning mechanism with first and second members arranged and configured such that *one of the first and second members undergoes reciprocating movement* with respect to the other of the first and second members and corresponding *first and second engagement surfaces* of the first and second members *selectively engage* each other in response to manual operation of said operator actuating member. Claim 1 goes on to require that a buffering member is mounted to at least one of the first and second members in an area such that the buffering member is contacted between the first and second engagement surfaces of said first and second members when *the first and second engagement surfaces move into abrupt engagement with one another* thereby *cushioning impact* between the first and second members.

This arrangement is *not* disclosed or suggested by the Ueng patent, the Rivin patent or any other prior art of record. The Ueng patent discloses a lever mechanism with a pawl and ratchet wheel where the pawl impacts the ratchet wheel in response to operation of a lever member. The Ueng patent is one of a plethora of patents that disclose pawl and ratchet wheel mechanisms that undergo such impacting. No buffering member is suggested or disclosed in the Ueng patent or in any other positioning mechanism patent that includes a reciprocating member.

The Rivin patent discloses a coating for gears where:

the sliding and external friction that would normally occur  
between gear teeth not having the coating is taken up by shear  
deformation of the coating. (see column 2, lines 21-24)

The gear coating teachings disclosed in the Rivin patent are for the sole purpose of improving shear force characteristics of meshed gears where sliding contact and sliding friction are of major concern. The specific teachings in the Rivin patent teach away from use in a device where a buffer member cushions impacting engagement, such as in the present invention.

Specifically, Rivin explicitly states that “if the coating is thick, the stiffness and load carrying capacity of the tooth gearing are drastically reduced.” See Rivin at column 4 lines 41-43. Rivin provides a rather detailed description of determination of the desired thickness of their coatings (see column 3, lines 33 through column 4 line 11). The Rivin patent stresses the importance of maintaining an extremely thin layer of material in order to enhance shear stiffness of the coating. ***More specifically, the coatings in the Rivin patent cannot be thick enough or resilient enough to cushion impacts between impacting surfaces.*** Such thin layers of material would not cushion impacts between two elements where one of the elements reciprocates relative to the other element, as required by independent claims 1 and 13. In fact, the thin layer taught in great detail by the Rivin patent would provide no cushioning effect whatsoever between two surfaces that undergo repeated abrupt impact.

Therefore, it would not be obvious for one of ordinary skill in the art to take the teachings of the Riven patent and combine them with the teachings of the Ueng patent to achieve the claimed invention because the Riven patent teaches away from cushioning impact between impacting elements.

It is well settled in U.S. patent law that the mere fact that the prior art can be modified does ***not*** make the modification obvious, unless the prior art ***suggests*** the desirability of the modification. However, the prior art teaches away from the combination suggested in the Office Action. The coatings of Rivin are not suitable for the impact cushioning required by the present invention. Accordingly, the prior art of record lacks any suggestion or

expectation of success for combining the patents to create the Applicants' unique arrangement of a positioning mechanism that includes a buffer member that cushions impact between a reciprocating element and another element where the reciprocating element impacts the other element.

It is also well settled in U.S. patent law that the mere fact that the prior art can be modified does *not* make the modification obvious, unless the prior art provides an *apparent reason* for the desirability of the modification. Since the prior art teaches away from the present invention, there is no apparent reason in the prior art for achieving the present invention. Accordingly, the prior art of record lacks any apparent reason, suggestion or expectation of success for combining the patents to create the Applicants' unique arrangement of a positioning mechanism that includes a buffer member that cushions impact between two elements.

Moreover, Applicants believe that the dependent claims 2, 3, 6, 8, 9 and 13 are also allowable over the prior art of record in that they depend from amended independent claim 1, and therefore are allowable for the reasons stated above. Also, the dependent claims 2, 3, 6, 8, 9 and 13 are further allowable because they include additional limitations. Thus, Applicants believe that since the prior art of record does not disclose or suggest the invention as set forth in independent claim 1, the prior art of record also fails to disclose or suggest the inventions as set forth in the dependent claims.

Therefore, Applicants respectfully request that this rejection be withdrawn in view of the above comments and amendments.

Applicants further assert that since claim 1 is now allowable, that all withdrawn claims be rejoined and allowed.

Appl. No. 10/697,989  
Amendment dated October 18, 2007  
Reply to Office Action of August 15, 2007

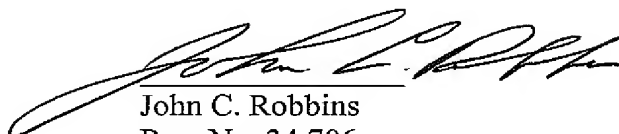
***Prior Art Citation***

In the Office Action, additional prior art references were made of record. Applicants believe that these references do not render the claimed invention obvious.

\* \* \*

In view of the foregoing amendment and comments, Applicants respectfully assert that claims 1-14 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,

  
John C. Robbins  
Reg. No. 34,706

SHINJYU GLOBAL IP COUNSELORS, LLP  
1233 Twentieth Street, NW, Suite 700  
Washington, DC 20036  
(202)-293-0444  
Dated: Oct. 19, 2007

S:\10-OCT07-SOS\SN-US035137 Amendment FOA.doc